

REMARKS

Claims 1-9, 11-22, 24-34, and 36-62 are pending. Claims 10, 23, and 35 have been canceled in this response.

The Abstract:

In the last Office Action response, Applicant tried to amend the Abstract in response to concerns of the Examiner that were never made completely clear. The Examiner has refused to enter this amendment, stating that it introduces new matter. Applicant disagrees that the amendments did not have support in the specification as filed. In any event, to remove the new matter rejection, Applicant here makes no amendment. (Because the earlier amendment was not entered, this strategy returns the Abstract to the way it was originally presented in the Application, hence mooted the new matter rejection).

If there are continuing concerns about the Abstract, The Applicant respectfully asks the Examiner to please be explicit in identifying the language that the Examiner finds objectionable, and why it is objectionable. As Abstracts are largely a pro forma matter, and to stop the back-and-forth on what should be a minor issue, it would also be appreciated if the Examiner could suggest exactly how he would like the Abstract worded so that the Applicant does not have to guess the Examiner's desire on this front.

Indefiniteness Rejections:

Claims 10, 23, and 35, which were rejected under 35 U.S.C. § 112, ¶ 2 as being indefinite, have been canceled.

Claims 28, 43, and 53, although not explicitly noted as rejected, but still criticized, have been amended to address the Examiner's concerns.

Rejections Based on Prior Art:

In responding to the Examiner's prior art rejections, Applicant here only justifies the patentability of the independent claims (i.e., claims 1, 14, 28, 43, and 53). As the

Examiner will appreciate, should these independent claims be patentable over the prior art, narrower dependent claims would also necessarily be patentable. Accordingly, Applicant does not separately discuss the patentability of the dependent claims, although it reserves the right to do so at a later time if necessary.

All of the independent claims 1, 14, 28, 43, and 53 stand rejected as obvious under 35 U.S.C. § 103 as being obvious given the combination of U.S. Patent Publication No. 2001/0039475 (“McCarthy”) and Applicant’s Admitted Prior Art (AAPA).

McCarthy comprises a “Mirror-Based Global-Positioning System (GPS) Navigation Solution.” McCarthy, Title. As is relevant here, McCarthy’s system includes a rear-view mirror which displays “driver information messages such as turn-by-turn instructions.” McCarthy, ¶ [0010]. An example of such an instruction is shown in the rear-view mirror assembly of Figure 1, which contains a dot matrix display 18 at its bottom, which in Figure 1 reads “Turn right on Swan. (.8 mi East).” McCarthy’s system, once provided a destination (see data input system 22, comprising 24, 30, or 26) and in conjunction with GPS technology, can provide such readable instructions to the driver to assist in making turns at the correct locations.

Claim 1

Claim 1 recites that the illuminated turn signal indicators comprises “a pair of indicators comprising a left turn indicator and a right turn indicator.”¹ The Examiner admits that McCarthy does not disclose this limitation. However, the Examiner notes that AAPA discloses this limitation.

It is important to understand what AAPA is at issue here. First, Applicant’s specification in the Background discusses prior art navigation systems. In such navigation systems as described by the Applicant, upcoming turns are indicated to the driver on the navigation system’s “user interface display, e.g., by displaying a text message (“right turn ahead”), by a flashing arrow, etc., which may or may not be associated with a map of the route or destination. Alternatively, the notification can be audible.” Specification, pgs. 1-2.

¹ In claim 1, these indicators are “proximate to an instrument cluster on a dashboard of the vehicle.”

But this discussion of prior art navigation systems by the Applicant does not disclose or suggest that upcoming turns are indicated to the driver through “a pair of indicators comprising a left turn indicator and a right turn indicator” proximate to an instrument cluster on a dashboard of the vehicle. Because this subject matter does not disclose this limitation missing from McCarthy, it cannot comprise the AAPA that is the basis for the Examiner’s obviousness rejection.²

Instead, the AAPA on which the Examiner relies has nothing to do navigation systems at all. Instead, and as the Examiner’s citations prove, ***the relevant AAPA is merely Applicant’s disclosure of a vehicle with typical pairs of turn signal indicators, such as the indicators 90 on the instrument cluster, the external indicators 102 proximate to the bumpers, or the external indicators 104 on the side view mirrors (see Applicant’s Figures 3 and 4).***

So the Examiner’s argument is that McCarthy plus such traditional pairs of turn signal indicators renders claim 1 obvious. Of course, and as the Examiner is no doubt aware, the Examiner must justify why one of ordinary skill in the art would have been suggested or motivated to make such a combination of these references.

Here, the Examiner provides no evidence of suggestion or motivation. Instead, the Examiner merely notes that the combination would have been obvious “for the purpose of effectively indicating left and right directions of travel to a vehicle occupant and to other vehicles in traffic.” Office Action at 4. ***But this reasoning is conclusory. It merely states why the Applicant’s invention is a good idea and provides beneficial results. But it does not explain why one would have been motivated to make the combination.*** This is classic hindsight reconstruction of the invention, which is impermissible in justifying an obviousness rejection.

An independent analysis shows that no evidence of suggestion or motivation is present. McCarthy does nothing to suggest that a pair of right and left turn signals (proximate to an instrument cluster on a dashboard) can be used in the context of his

² Were this prior art navigation system subject matter the AAPA referred to by the Examiner, the combination of McCarthy and AAPA would not disclose the limitation missing from McCarthy. Therefore, even if were proper to combine these references, they could not render claim 1 obvious, because the combination would lack a disclosure of all of the claim limitations. See MPEP 2143.03.

navigation system. And the relevant AAPA does nothing to suggest that traditional right and left turn signals (proximate to an instrument cluster on a dashboard) can be used in the assistance of a navigation system such as McCarthy's. In short, the evidence provided by these references shows no suggestive or motivated link between the use of vehicle navigation systems (such as that disclosed in McCarthy) and traditional paired vehicle turn signal indicators (AAPA).

The Examiner here has merely picked and chosen the limitations of claim 1 from McCarthy and from AAPA without proper regard to whether such a combination of references would have been suggested to one of ordinary skill in the art. As a result, the obvious rejection of claim 1 (and claims dependent thereon) cannot stand.

Claim 14

Claim 14 recites that the "the turn signal indicator is external to the vehicle." The Examiner admits that McCarthy does not disclose this limitation. However, the Examiner notes that AAPA discloses this limitation.

The Examiner here offers exactly the same rationale for obviousness that was offered for claim 1, namely that the combination would have been obvious "for the purpose of effectively indicating left and right directions of travel to a vehicle occupant and to other vehicles in traffic." Office Action at 7.

But this reasoning is faulty for the same reason as discussed above with respect to claim 1.³ To briefly reiterate, it is conclusory, and not supported by any evidence of suggestion or motivation as necessary to support an obviousness rejection: McCarthy does nothing to suggest that external turn signal indicators can be used in the context of his navigation system. And the relevant AAPA does nothing to suggest that traditional

³ Again, the only relevant AAPA is the disclosure of standard external turn signal indicators, such as those traditionally placed on a vehicle's bumper 102 or on the side view mirrors 104. See Applicant's Figure 4.

Applicant's discussion in the Background section of prior art navigation systems cannot comprise the AAPA, because that subject matter does not disclose McCarthy's missing limitation of use of a "the turn signal indicator . . . external to the vehicle," and hence that subject matter would be an inadequate addition to McCarthy to render claim 14 obvious. See MPEP 2143.03.

external turn signal indicators can be used in the assistance of a navigation system such as McCarthy's. In short, the evidence provided by these references shows no suggestive or motivated link between the use of vehicle navigation systems (such as that disclosed in McCarthy) and traditional external turn signal indicators (AAPA).

As a result, the obvious rejection of claim 14 (and claims dependent thereon) cannot stand.

Claims 28, 43, and 53

Claims 28, 43, and 53 recite that the turn signal indicator is "independently manually activated by a driver of the vehicle using a turn signal selector." The Examiner admits that McCarthy does not disclose this limitation. However, the Examiner notes that AAPA discloses this limitation.

The Examiner here offers exactly the same rationale for obviousness that was offered for claim 1, namely that the combination would have been obvious "for the purpose of effectively indicating left and right directions of travel to a vehicle occupant and to other vehicles in traffic." Office Action at 9, 12, 14.

But this reasoning is faulty for the same reason as discussed above with respect to claim 1.⁴ To briefly reiterate, it is conclusory, and not supported by any evidence of suggestion or motivation as necessary to support an obviousness rejection: McCarthy does nothing to suggest that an independently manually-activated turn signal selector can be used in the context of his navigation system. And the relevant AAPA does nothing to suggest that a traditional independently-manually-activated turn signal selector can be used in the assistance of a navigation system such as McCarthy's. In

⁴ Again, the only relevant AAPA is the disclosure of manually activating a turn signal indicator using a standard turn signal selector 94, such as those commonly coupled to a vehicle's steering column. See Applicant's Figure 3.

Applicant's discussion in the Background section of prior art navigation systems cannot comprise the AAPA, because that subject matter does not disclose McCarthy's missing limitation of use of a turn signal indicator that is "independently manually activated by a driver of the vehicle using a turn signal selector." Hence, this background subject matter would be an inadequate addition to McCarthy to render claims 28, 43, and 53 obvious. See MPEP 2143.03.

short, the evidence provided by these references shows no suggestive or motivated link between the use of vehicle navigation systems (such as that disclosed in McCarthy) and a traditional manually-activated turn signal selector (AAPA).

As a result, the obvious rejection of claims 28, 43, and 53 (and claims dependent thereon) cannot stand.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless the Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

The Applicant believes that the subject application, as amended, is in condition for allowance. Such action is earnestly solicited by the Applicant.

In the event that the Examiner deems the present application non-allowable, it is requested that the Examiner telephone the Applicant's attorney at the number indicated below so that the prosecution of the present case may be advanced by the clarification of any continuing rejection.

Please charge any fees that may be due to Deposit Account 502117, Motorola, Inc.

Respectfully submitted,

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